

Role description

Associate / Senior Associate (Trade
Mark Attorney)

The opportunity for you

Principal responsibilities

The successful candidate will work with a high degree of autonomy but will work closely with the partners and other senior team members. They will be instructing and supervising more junior attorneys, trainee trade mark attorneys and paralegals. Depending on seniority, it is intended they would be heading the Liverpool team of associates and paralegals, reporting to the head of the UK brand protection portfolio practice.

- Managing national and international trade mark portfolios and providing high quality holistic brand management support.
- Handling trade mark conflicts and registry disputes, including advising on strategies to defend, prosecute and settle oppositions, cancellation and revocation actions.
- Coordinating high volume/standard infringement disputes which may be related to registry actions, including preparing and sending cease and desist letters, dealing with follow up correspondence, negotiating settlements (working alongside solicitor associates if the dispute becomes more contentious and litigious).
- Conducting and advising on trade mark availability searches, using appropriate online tools and through search agents.
- Advising clients on registrability of trade marks and recommending cost-effective registration strategies.
- Filing and prosecuting trade marks on a worldwide basis, including the UK, EU and Madrid system.
- Gathering and presenting witness statement evidence to show acquired distinctiveness, reputation or for infringement purposes, including instruction of investigators.
- Drafting legal submissions for UKIPO or EUIPO proceedings and handling UKIPO hearings (whether doing advocacy themselves or through counsel).
- Advising on assignment or recordal projects and implementing them to run within budget, on time and with efficient reporting.
- Advising on and handling domain name/company name complaints.
- Instructing and managing work of foreign attorneys, including critically reviewing their invoices before approval.
- Supervising the review of watch notices and advising on possible oppositions.
- Assisting with management of portfolio disbursements, matter billing and client payment for their matters in a timely and efficient manner to help improve matter profitability (including liaising with specialist trade mark billers and credit control teams).

Job title

Associate / Senior Associate
(Trade Mark Attorney)

Recruiting manager

Roland Mallinson

Department

Technology IP & Information

Working hours

Monday to Friday (09:30 – 17:30)

Working at least 3 days a week from our offices.

Location

Liverpool

Perm/FTC

Permanent

Salary

Competitive

Working pattern

Taylor Wessing supports agile working, and the Talent Acquisition team would happily have conversations with potential candidates about how we could support agile or flexible working needs.

The opportunity for you

Know How and Business Development:

- Proactive contribution to business development, offering thought leadership and building the profile of the firm in this area, e.g. building and using a network of contacts, writing articles and securing their publication, attending industry events and being actively involved in industry organisations, public speaking including webinars.
- Assisting partners to develop and strengthen existing client relationships and build new ones.
- Participation in client pitch preparations and attending pitch meetings
- Working with partners on issues of pricing and giving (and managing compliance with) cost estimates for filing, recordal, clearance or other projects.
- Volunteering ideas to improve business practices.
- Actively contributing to internal know how and at team meetings, e.g. giving internal training, reviewing cases for internal discussion sessions.
- Being a supervisor for trainee trade mark attorneys and providing career guidance and development to help them through the CITMA qualification process.

Knowledge, skills and experience

The role is intended to be a mid to senior trade mark assistant/attorney role, perhaps up to about 10 years PQE (but this will not be determinative). There is no need for a client following.

We are looking for a candidate experienced with working autonomously and directly with clients to manage their portfolios in a wide range of industry sectors and capable of managing, supervising and developing a team. One or more of those portfolios will be reasonably substantial and active.

Experience of handling cases at the UKIPO and EUIPO is essential, as is working with foreign associates. Any experience working in an in-house trade mark department of a brand owning company could be useful but is not required. Candidate should preferably be a CITMA qualified attorney, but other qualifications will be considered.

The following skills are essential:

- A real enthusiasm for trade mark law, a passion for brands and self-motivation.
- Sound judgment on merits and risks of claims, reflecting experience and commercial reality.
- Good oral and written communication and advocacy skills.
- Strong attention to detail and accuracy in work.
- Strong academics and technical ability.
- Well organised and ability to prioritise and manage their own high volume workload
- Commercially astute and practical.
- Ability to quickly engender trust and rapport with team members and many different types of clients.

Technology IP & Information

Our UK Brand Protection practice sits within our 75-strong UK Technology IP & Information (TIPI) group group. The team is split between our London and Liverpool offices, with no difference between the type of clients and nature of work undertaken by the two teams. The brands practice is part of our wider international TIPI practice which is one of the most highly respected around the world. Due to the strength and depth of our expertise, Taylor Wessing has an outstanding reputation in the field of IP and IT.

The team advises global clients on a wide range of IP issues through the full lifecycle of a business, and across a large variety of matters. Our international Brand Protection practice is not just one of the largest practices of its type, it is also among the top rated, with a major international trade mark filing and portfolio practice that is strategically core to the firm. Taylor Wessing has been consistently ranked Band 1 for Brand Management in Legal 500 and top tier by WTR1000, with a number of team members individually identified as leaders in their field.

This, together with the variety of the brands we represent across all business sectors, means that we have outstanding experience in every area of trade mark and design law. By integrating all aspects of trade mark and design practice into one team, we provide a full IP service, advising not just on clearance, prosecution and portfolio management, but also anticipating and handling disputes and litigation. Advising clients ranging from those with extensive international portfolios to SMEs and start-ups, we have an excellent track record in successfully resolving high-profile and complex brand disputes throughout Europe and Asia. We have recently added core IP/IT strength to our Dubai office and also offer full brand protection services across the MENA region.

Technology IP & Information



Roland Mallinson
Partner

[> Click here for full bio](#)

Roland is the head of our Brand Management group in the UK. For over 20 years he's advised major international brand and technology owners on their IP rights. Clients describe Roland as a tactically smart, solutions-focused, and commercially-minded. He's responsible for the international trade mark portfolios and IP advisory work for numerous household name brands.

Roland advises on the full range of contentious and non-contentious "soft" IP matters, including: trade mark, designs and copyright disputes and litigation, lookalikes, anti-counterfeiting, domain name and content infringements, trade mark clearance, prosecution, oppositions and strategic portfolio advice, comparative advertising, and all types of commercial transactions involving these rights.

He's led first instance and appeal cases in the English courts, the UKIPO, the EUIPO and CJEU and taken part in a number of successful mediations, and regularly coordinates crossborder IP litigation in the EU.



Aneka Dalton
Partner

[> Click here for full bio](#)

Aneka is a brands litigation specialist with over fifteen years of experience representing multinational clients in high-stakes IP disputes before the Courts. Clients value her pragmatism and ability to navigate complex disputes towards a commercially-oriented outcome.

Aneka acts for clients in contentious "soft" IP matters, with a particular focus on trade mark litigation as well as disputes before the UK Intellectual Property Office, Nominet and WIPO. She has acted for some of the largest multinational brand owners in the technology, media, e-commerce and consumer sectors in infringement litigation, invalidity actions, ISP liability claims and licensing disputes, including cross-border IP litigation. She is a solicitor-advocate with higher rights of audience before the Courts of England and Wales.

Aneka also advises clients on every aspect of their brand strategy, including the development, protection, exploitation and enforcement of IP rights.

About us

Taylor Wessing is a global law firm that serves the world's most innovative people and businesses.

Deeply embedded within our sectors, we work closely together with our clients to crack complex problems, enabling ideas and aspirations to thrive. Together we challenge expectation and create extraordinary results. By shaping the conversation in our sectors, we enable our clients to unlock growth, protect innovation and accelerate ambition.

Our UK sector focus



Technology, Media
& Communications



Private Wealth



Real Estate,
Infrastructure & Energy



Life Sciences
& Healthcare

Our areas of expertise

- Banking & Finance
- Brands & Advertising
- Commercial & Consumer Contracts
- Competition, EU & Trade
- Copyright & Media Law
- Corporate Crime & Compliance
- Corporate/M&A & Capital Markets
- Data Protection & Cyber
- Disputes & Investigations
- Employment, Pensions & Mobility
- Environmental, Planning & Regulatory
- Financial Services Regulation
- Information Technology
- Patents & Innovation
- Private Client
- Private Equity
- Projects, Energy & Infrastructure
- Real Estate & Construction
- Restructuring & Insolvency
- Tax
- Venture Capital

Challenge expectation, together

With our team based across Europe, the Middle East, US and Asia, we work with clients wherever they want to do business. We blend the best of local commercial, industry and cultural knowledge with international experience to provide proactive, integrated solutions across the full range of service areas.

1000+ lawyers | **300+** partners | **29** offices | **17** jurisdictions

About us

The way we work

At Taylor Wessing, we never settle for average. We're creative thinkers, problem solvers and continuous learners who excel at what we do and believe our best work is still ahead of us. We are a firm that's large enough for you to achieve your ambitions, but connected enough to be a true community.

You are joining an inclusive culture that allows you to be yourself and balance your work and home commitments. You'll gain access to high-end technology, agile processes and the trust to deliver your best work in a flexible way whilst spending the balance of your time with colleagues in our offices.

Investing in you | Tailored Benefits

Your wellbeing is always our priority and we are proud to offer bold and progressive ways of working alongside an excellent range of benefits and perks designed to support you and your family.

Key benefits

- 25 days' annual leave
- Life assurance
- Group personal pension – salary sacrifice
- Income protection
- In-house GP service

Health and wellness benefits

- Private medical insurance (individual)
- Health assessments
- Dental insurance
- Critical illness insurance
- Flu vaccinations
- Eye tests
- Employee assistance programme
- GymFlex

Lifestyle benefits

- Cloud Nine – our subsidised restaurant and coffee bar
- Enhanced family leave – after one year qualifying service new parents taking maternity or shared parental leave may receive the equivalent of six months' full pay, spread over nine months
- Cycle to work scheme
- Payroll giving
- Technology loan
- Health cash plan
- National Art Pass
- Mortgage surcharges
- Interest free season ticket loan

Our values

What we stand for

We are a community of independent thinkers, connected by our values and our drive to challenge expectation. Our values shape what we do and how we do it. We have built a team that reflects the firm's core values and which exemplifies inclusivity. To learn more, [click here](#).

Excellence

Creative

Responsible

Team

Integrity

Respect

Acting responsibly, together

We're committed to being a responsible business and taking accountability for our actions.

We have high ethical standards and take care of our people. We're reducing the footprint we leave in nature and engaging with our communities through cultural and charity work. Being a responsible business means we're active members of our broader society, of the legal community, and of our clients' sectors.

Whether it's building an inclusive workplace, reducing our waste or supporting the arts; we're actively working together to build a better business, and a more sustainable world.

Find out more about our responsible business initiatives [online](#).

Read our latest impact report by clicking the link below.



Diversity & Inclusion

Mansfield Certification

Taylor Wessing UK is proud to have achieved Mansfield Rule UK certification for a second year running and has committed to participating for a third year!

We're committed to delivering an inclusive culture and a progressive environment where we empower all our people to lead, learn and grow. The Mansfield Rule keeps us and the wider legal profession accountable for achieving and surpassing these goals; over the last year alone the Mansfield Rule has helped us continue to focus on monitoring our recruitment and promotion activities, as well as improving the diversity of our firm.

We've seen tangible changes in our firm from championing diverse voices across all areas of our business, something we want to see continue to flourish in the years to come and with Mansfield as a key partner in building in an inclusive environment for all.

To read more about this fantastic achievement please [click here](#)



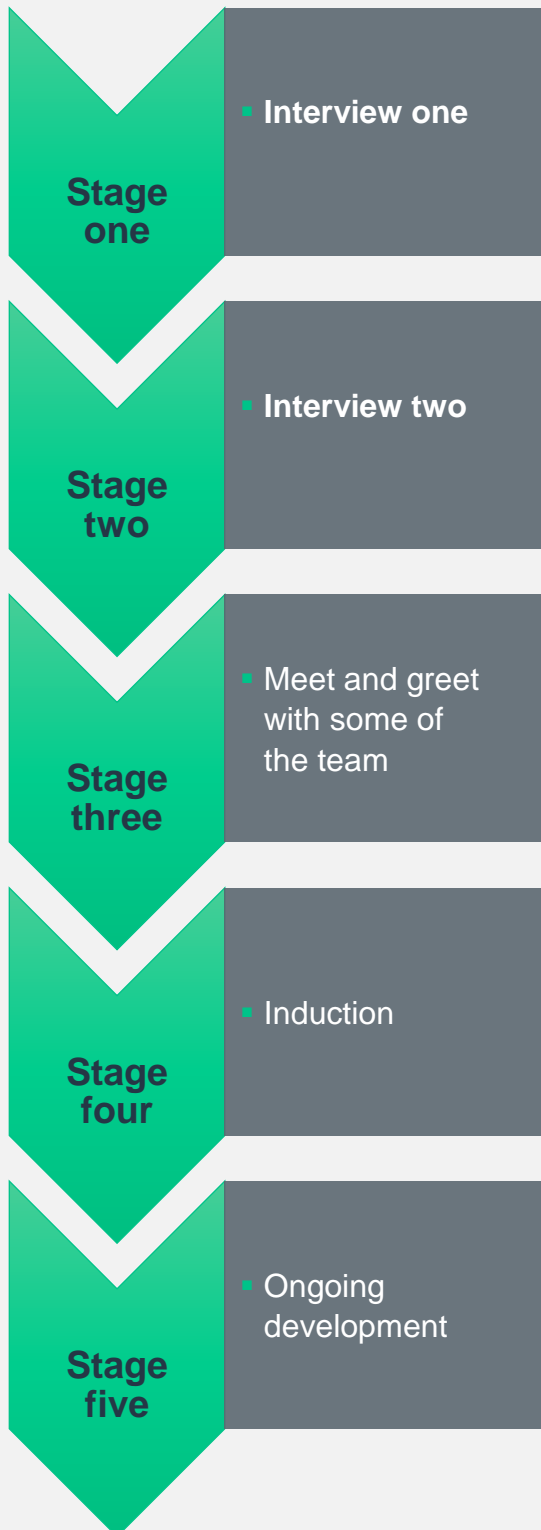
Responsible Business Networks

We embrace individuality and bring diverse teams together, creating an inclusive work environment where all of our talent can flourish. Our inclusion programme has five priority areas, each with partner champions and network groups, in addition to other networks and societies that bring people together within the responsible business programme.

Our current networks are:

- Arts Society
- Balance in Business - our gender balance network
- Cultural Diversity network
- equaliTW - our LGBTQ+ network
- Family Matters network
- Social Mobility network
- Sustainability network
- Wellbeing network

Your recruitment journey



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Please contact us if you require any adjustments to your application or our recruitment process.

2000+ people
1100+ lawyers
300+ partners
29 offices
17 jurisdictions

Austria	Klagenfurt Vienna
Belgium	Brussels
China	Beijing Hong Kong Shanghai
Czech Republic	Brno Prague
France	Paris
Germany	Berlin Düsseldorf Frankfurt Hamburg Munich
Hungary	Budapest
Netherlands	Amsterdam Eindhoven
Poland	Warsaw
Republic of Ireland	Dublin
Slovakia	Bratislava
South Korea	Seoul*
UAE	Dubai
Ukraine	Kyiv
United Kingdom	Cambridge Liverpool London London TechFocus
USA	New York Silicon Valley

* In association with DR & AJU LLC